

REMARKS/ARGUMENTS

1. Claims 2-4 are rejected under 35 U.S.C. §101 as directed to non-statutory subject matter. The basis for Examiner's decision appears to be set forth in the bottom paragraph of page 2 of the Final Rejection "By applicant's own admission, the claims are not limited to being performed by a computer. As a matter of fact, there is no computer or machine recited in claims 2-4 . . ." and on page 3, second paragraph "Applicant's claims do not recite any sort of technology."

This basis for continued rejection is traversed, as the Board of Patent Appeals and Interferences has made it clear in a *per curiam* decision that business method claims are patent-eligible even if not tied to "technological arts" (Ex part Lundgren, No 2003-2088, November 5, 2005, on application 08/093,516). The particular issue decided was whether there is a separate "technological arts" test for determining if the claims are statutory under 35 U.S.C. §101. The board found that there is no "mental steps" limitation to patentability.

Claims 2-4 are patentable in a 35 U.S.C. §101 sense.

2. Claims 3-4 stand rejected under 35 U.S.C. §112 as indefinite. This basis for rejection is traversed.

Examiner indicates that claims 3 and 4 are indefinite because the "next-to-last step of claim 3 recites that the most remote one of the determined arrival dates is selected as the integrated logistic support (ILS) date; however, the last step of claim 3 recites that the ILS date is compared to the selected date. If the selected

date is the next to last step of claim 3, then why would a further comparison be performed?"

In general, the invention relates to the determination of whether a particular upgrade of a major asset (a ship in the example) can be accomplished on a desired selected date (generally in the future), as for example on the date at which a drydock becomes available. In order to make this determination, an "Integrated Logistics Support" date is determined. The ILS date represents the date at which all the materials required for the upgrade are (or are promised to become) available. A simple comparison of the ILS date (at which the materiel becomes available) with the desired selected date (at which the upgrade is to begin) will indicate whether the acquisition process has been accomplished or not, and whether the upgrade can go forward.

Thus, it is perfectly understandable that the two dates would be compared. Examiner comments in the paragraph extending from page 5 of the Final Rejection to page 6 that he assumes that "by setting the ILS date as the selected date, an inherent comparison is performed between the two dates." In general, the ILS date is determined by the vendors who supply the materiel for the upgrade, as it depends upon their ability to supply. The desired or selected date, however, is determined by other considerations (the date on which it is desired to perform the upgrade) which in general is a different date from the ILS date. It would be mere happenstance if the dates were to coincide.

Claims 3 and 4 are patentable in a 35 U.S.C. §112 sense.

3. Claims 2-4 are rejected under 35 U.S.C. §103(a) as unpatentable over applicant's admitted prior art as disclosed on pages 1-5 of the specification.

Generally, a §103 rejection presupposes that plural references are applied and are combined in some manner. Even when plural references are applied, the structure rendered obvious by the suggested combination of references must exactly correspond with the claimed invention in order to sustain the 35 U.S.C. §103 rejection. That is, a failure of the suggested combination of references to make out every salient limitation of the claim in question renders the claim patentable as to §103. Single-reference rejections are subject to 35 U.S.C. §102, where the same exact correspondence is required between what is described by the reference and the salient recitations of the claims. In the present instance, only the admitted prior art is applied, and the rejection is therefore treated as being under 35 U.S.C. §102.

Examiner states (page 6 of the Final Rejection, under heading "9" that "Applicant's admitted prior art discloses a method for determining whether a ship upgrade can commence on a selected date, said method comprising the steps of : generating a change document . . ." Examiner references Page 1, lines 9-12 and Page 4, lines 12-26. The matter found at page 1, lines 9-12 relates not to a change document but instead to "projection of job completion dates" and the matter at page 4, lines 12-26 relates to how technical manuals are handled. Thus, the portions of the specification adverted to by Examiner do not support his assertion. The Background of the Invention has been scrutinized, without finding any reference whatever to a "change document." The "change document" is found in the

first clause of claim 3 of the application, and since it is not found in the Background of the Invention it represents a first salient difference between the recitations of claim 3 and the prior art. This alone would be sufficient for patentability of claim 3.

Further, Examiner states (bottom of page 6 of the Final Rejection) that the admitted prior art discloses "associating said change document with a ship having said particular type of equipment." Examiner notes that the admitted prior art "acknowledges that, while this is a difficult task, it needs to be, i.e. has been already been [sic], performed. Again, it must be said that the Background of the Invention does not even mention a change document. Consequently, it cannot describe the "association" of the nonexistent element with anything, much less with a ship having particular equipment. Examiner's contention in this regard is erroneous. Thus, claim 3 contains a second substantive clause which is not found in the admitted prior art. This alone would be sufficient for patentability of claim 3.

Examiner's comments near the top of page 7 of the Final Rejection suggests that the admitted prior art reveals "associating a particular upgrade with the change document (Page 4, lines 12-15)" This is simply wrong. Page 4, lines 12-15 are directed toward the handling of technical manuals. The language "associating a particular upgrade with the change document" tracks that of a clause of claim 3. Since this language is not anticipated or rendered obvious by the portion of the admitted prior art referenced by Examiner, it must be deemed to constitute a substantive difference of claim 3 over the admitted prior art. Taken alone, this would be sufficient to render claim

3 patentable in a 35 U.S.C. §103 sense.

Without belaboring the point, it must be said that claim 3 contains other clauses which distinguish over the admitted prior art.

Examiner asserts obviousness in his argument at page 8 of the Final Rejection. Applicant agrees that the use of the prior art method would be obvious. It appears that Examiner is arguing that the claimed invention is obvious over the admitted prior art since the result in either case is upgrade of the ship when the parts are available. However, patentability is not negated in a method simply because the result of the method may be the same as the result of a prior-art method. The real issue is whether the method steps are the same or obvious thereover. In this case, the method steps are not found in the prior art. Consequently, claim 3 and its dependent claim 4 are patentable in a 35 U.S.C. §103 sense over the admitted prior art.

4. In conclusion, claims 2, 3, and 4 are patentable.

5. Reconsideration and allowance are requested.

6. No fee is believed to be required for this amendment. Please charge any other fees to deposit account 50-2061.

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CERTIFICATE OF MAILING BY FIRST CLASS MAIL (37 CFR 1.8)

Applicant(s): Jackson

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Examiner

Susanna M. Meinecke Diaz

Customer No.

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Group Art Unit

3623

Invention: INSTALLATION SUPPORT INFORMATION SYSTEM COLLABORATIVE TOOL



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